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Docket No. 740756-945

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent application:)
Hisato SHINOHARA et al.)
Application Serial No. 08/169,127) Art Unit: 1762
Filed: December 20, 1993) Examiner: Marianne L. Padgett
For: METHOD AND SYSTEM OF)
LASER PROCESSING)

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated February 13, 2003, Applicants elect, with traverse, "Species c" as identified in the Office Action.

Applicants respectfully submit, that in accordance with MPEP 806.04(e) that:

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Species are always the specifically different embodiments.

Species are *usually* but not always independent as disclosed (see MPEP § 806.04(b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect.

Furthermore, while Applicants are *not* addressing the patentable distinction, if any, between the presently pending claims, in general, and to support a species type election requirement, Applicants respectfully submit that in accordance with MPEP 806.04(h), the Office must provide evidence that the species are patentably distinct from each other.

Based at least on the above MPEP sections, Applicants respectfully submit the February 13 Office Action is defective. In particular, paragraph 1 of the Office Action specifies four sets of claims that are alleged to be different species. As outlined above, claims are never species. In order for a species election to be appropriate, different embodiments or figures of the invention should be identified as being the allegedly different species, at which time, and in response to the election requirement, the Applicant identifies the claims associated with the identified species.

Secondly, paragraph 1(a) of the Office Action identifies the first species as a "laser crystallization of semiconductor films" and paragraph 1(d) identifies a "laser treatment of a semiconductor film" as the fourth species. However, upon reviewing claim 11, which the Office associates with identified Species a, it is noted that the relevant portion of claim 11 reads:

...irradiating said semiconductor film with the condensed laser beam to crystallize said semiconductor film...

Claim 113, which is identified by the Office as being associated with the fourth species recites:

...irradiating said semiconductor film with the condensed laser beam to crystallize said semiconductor film...

Applicants respectfully submit that they are having difficulty reconciling how a distinction is drawn between Species a and Species d based on the above terminology identified by the Office. Comparable arguments can be made for Species b and Species c. Although the features of Species A and Species D, if defined properly, may be patentably distinct, Applicants respectfully submit that in compliance with the MPEP, the Office is required to provide some reasoning as to why the identified species are patentably distinct from each other. Applicants have carefully reviewed the outstanding Office Action and have failed to find statements to this effect.

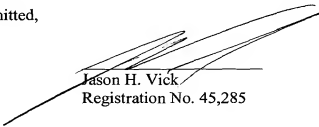
Additionally, 35 U.S.C. 121 provides that restriction may be required to one of two or more independent and distinct inventions. However, 37 CFR 1.141 provides that a reasonable number of species may still be claimed in one application if the other conditions of the rule are met. While Applicants respectfully assert the identified claims may be related combination-subcombination claims, for sake of argument, based on the history of this application, and the discussions during numerous interviews, Applicants respectfully submit

that even if the claims are determined to be separate species, Applicants are claiming a reasonable number of species that may well be patentably distinct from each other.

Accordingly, Applicants respectfully submit the election of species requirement be withdrawn and/or reconsidered in view of the above arguments.

Lastly, it is noted that a separate Extension of Time Petition (three months) accompanies this response along with a check in payment of the requisite extension of time fee. However, should that petition become separated from this Response, then this Response should be construed as containing such a petition. Likewise, any over payment or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740756-945).

Respectfully submitted,



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